

REMARKS

In the October 20, 2003 Office Action, the Examiner rejected claims 1-7 as obvious under 35 U.S.C. § 103(a) over Shimizu (JP 11-142878). Applicants respectfully traverse.

The Examiner alleges that with respect to claims 1, 2, and 5, Shimizu teaches "a method of forming an image display unit which comprises forming a display element layer (43, light emitting diode) on a wafer (1st substrate), composed of display elements arrayed on a specific cycle, and separating the display element layer into the individual display elements while keeping the array of the display elements; a selective resin/UV step of selecting the elements to be transferred and applying adhesive resin, and irradiating them with UV rays so that the selected display units are distinguishable from the non-selected display elements; ..." The Examiner also admitted that Shimizu "is silent to the elements having a magnetic film, and using the magnetic film to transfer the elements onto a mounting board." The Examiner argued that "although Shimizu is silent to the exact steps taken to use magnetic forces in a manufacturing process, one of ordinary skill in the art will recognize that a magnetic film is needed, instead of a layer of adhesive resin..." The Examiner bases the argument on paragraph [0063] of Shimizu which states that "magnetic forces may be used instead of UV adhesive resin."

Applicants respectfully submit that the Examiner has failed to make a *prima facie* case of obviousness. The Examiner begins with Shimizu's statement that "magnetic forces may be used instead of UV adhesive resin" and states in a conclusory manner that the exact steps taken to use magnetic forces in a manufacturing process would be known to those of ordinary skill in the art. Applicants respectfully submit that the Examiner's conclusory statements fail to make a *prima facie* case of obviousness. The Examiner has failed to identify any motivation for one of ordinary skill in the art to use magnetic forces and to take the exact steps to use magnetic forces.

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of

the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

Applicants respectfully submit that Shimizu teaches using a resin adhesive, which is similar to the process described in the Background of the Invention. See Specification, pg. 1-6. Applicants teach in the Background that the problem with the process using resin adhesive is that handling becomes difficult and production costs are raised. *Id.* at pg. 3. Applicants then teach the claimed process to overcome the problems identified in the art. In rejecting claim 1, the Examiner claimed that substituting the adhesive resin with magnetic forces would have been obvious to those of ordinary skill in the art, but identified no motivation or reason for doing so. Quite simply, Shimizu does not teach any reason to use magnetic forces and accordingly fails to suggest taking the steps that it does not disclose to arrive at the claimed invention.

Independent Claim 1 is therefore not obvious over Shimizu and accordingly in condition for allowance. Claims 2-7 are dependent on claim 1 and therefore similarly allowable for the same reasons.

Respectfully submitted,

Dated: 7-28-04

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